

REMARKS

Claims 1 and 2 are presented for reconsideration in view of the following remarks. Claim 3 is newly presented for a first action on the merits.

In the outstanding Office Action, the Examiner rejected claims 1 and 2 under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) and in view of U.S. Patent No. 6,181,436 to Kurachi (hereinafter referred to as "Kurachi") and U.S. Patent No. 5,671,669 to Okuda (hereinafter referred to as "Okuda").

By this Response and Amendment, new claim 3 is provided to better clarify the presently disclosed inventive subject matter, and the rejection of claims 1 and 2 is respectfully traversed.

Support for new claim 3 can be found, for example, in claim 1 as originally filed, and at paragraph [0038] of the published application, which recites that "[t]he controller...controls the stencil printing machine...to execute a secret operation after the data is printed by the number of copies designated by the printer driver," and in paragraph [0043] of the published application, which recites that "after the completion of printing, the used stencil sheet is removed from the print drum...and the removed stencil sheet is disposed of."

Therefore, it is respectfully submitted that no new matter, within the meaning of 35 U.S.C. §132, has been introduced. In addition, the amendments are meant only to clarify the invention as set forth in the application as filed, and are not intended to limit the scope of the claims.

Rejections Under 35 U.S.C. §103(a)

The Examiner rejected claims 1 and 2 as being unpatentable over AAPA in view of Kurachi and Okuda.

Response

Applicant respectfully traverses the Examiner's rejection. Reconsideration and withdrawal of the rejection is requested since not all of the features of the claims are disclosed, taught, or suggested by the prior art, and since the Examiner is ignoring the required tenets for applying 35 USC 103.

Not all of the features of the claims are disclosed, taught, or suggested by the prior art.

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) that the prior art references teach or suggest all of the claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

Claim 1, as amended, recites “[a] printer driver...for setting items of various printing conditions for [a] stencil printing machine including a number of copies to be printed” which determines if a watermark print item is selected. If so, “the printer driver automatically selects a secret operation item... instructing said stencil printing machine to remove a used stencil sheet from a print drum and dispose of said used stencil sheet after said number of copies have been printed[.]” (Present application, claim 1)

Claim 2, as amended, recites “[a] printer driver...for setting items of various printing conditions for [a] stencil printing machine including a number of copies to be printed” which

determines if a “secret operation item is selected.” If so, “the printer driver automatically selects a secret keeping operation ... instructing said stencil printing machine to remove a used stencil sheet from a print drum and dispose of said used stencil sheet after said number of copies have been printed[.]” (Present application, claim 2)

The Examiner acknowledges that the AAPA does not teach the feature of incorporating a secret operation setting into the printer driver, and moreover does not teach the feature of automatic selection of the secret operation setting if the printer driver determines that a watermark print is selected, and moreover does not teach the feature of removing a used stencil sheet from a print drum.

The Examiner cites Kurachi and Okuda in attempting to cure the deficiency of AAPA.

Kurachi teaches a print managing system and print managing method. In Kurachi, “[a] secret setting information input device (not shown) enables the selection whether or not [an] encryption is executed.” (Kurachi, column 13, lines 55 – 62).

Okuda is drawn to a stencil printing machine. The machine includes a stencil discharge section for removing the stencil sheet from the printing drum after printing. (Okuda, abstract)

Neither Kurachi nor Okuda cures the deficiency of the AAPA, as they both fail to disclose, teach, or suggest a printer driver having a secret keeping operation “instructing said stencil printing machine to remove a used stencil sheet from a print drum and dispose of said used stencil sheet after [a selected] number of copies have been printed.” (Claims 1 and 2, emphasis added)

As clearly set forth in previous responses, the “secret keeping operation” of Kurachi is drawn only to encrypting print data and withholding print job information. Kurachi is completely silent as to a secret keeping operation instructing the printing machine to “remove” or “dispose” of any physical element, let alone removing a used stencil sheet from a print drum and disposing of the used

stencil sheet after all copies have been printed. Kurachi is also completely silent as to any printer driver which enables any secret keeping operation *of this kind*. The mere fact that Kurachi calls a feature a “secret keeping operation” does not equate this feature with the presently disclosed operation for “remov[ing] a used stencil sheet from a print drum and dispose of said used stencil sheet after [a selected] number of copies have been printed.”

Further, Applicant has carefully reviewed Kurachi, and has failed to find any reference to a printer driver “for setting a number of copies to be printed” which enables a secret keeping operation which occurs “after [the set] number of copies have been printed” as in the present application, claims 1 and 2. In contradistinction to the presently claimed invention, the “secret keeping operation” of Kurachi takes place *before* anything is printed (see, for example, Kurachi, figs. 3 and 9, in which the printing device is the final output device; see also Kurachi, col. 4).

Accordingly, Kurachi does not disclose, teach, or suggest a printer driver having a secret keeping operation “instructing said stencil printing machine to remove a used stencil sheet from a print drum and dispose of said used stencil sheet after [a selected] number of copies have been printed.” (Claims 1 and 2)

While Okuda describes a stencil discharge section for removing the stencil sheet from the printing drum, Okuda makes no reference to the use of a printer driver to control the stencil printer at all. In fact, Applicant cannot locate even one use of the word “driver” in Okuda.

Accordingly, Okuda does not disclose, teach, or suggest a printer driver having a secret keeping operation “instructing said stencil printing machine to remove a used stencil sheet from a print drum and dispose of said used stencil sheet after [a selected] number of copies have been printed.” (Claims 1 and 2)

As the combination of AAPA, Kurachi, and Okuda fails to disclose, teach, or suggest a printer driver having a secret keeping operation “instructing said stencil printing machine to remove a used stencil sheet from a print drum and dispose of said used stencil sheet after [a selected] number of copies have been printed,” Applicant submits that the Examiner has failed to make a *prima facie* case of obviousness.

Reconsideration and withdrawal of the rejections are requested.

The Examiner is ignoring the required tenets for applying 35 USC 103.

Further, Applicant respectfully submits that, in combining Kurachi with Okuda, the Examiner is ignoring the required tenets for applying 35 USC 103, as set out in the MPEP at section 2141:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

Applicant respectfully submits that, in the outstanding Office Action, the Examiner fails to consider the claimed invention as a whole and applies impermissible hindsight.

The Examiner states on page 3 of the outstanding Office Action that “it would have been obvious to one of ordinary skill in the art at the time of the invention was made [sic] to modify

applicant's admitted prior art printer driver as per teachings of Kurachi by incorporating "secret operation features" onto printer driver," and on page 4 of the outstanding Office Action that "it would have been obvious...to modify conventional stencil printing device [sic] to include a stencil discharge section for removing the used stencil sheet from the printing drum."

The Examiner has only purportedly shown that it would be obvious to add a "secret operations feature" to a printer driver, and to add a "stencil discharge section" to a printing device.

The presently disclosed invention sets forth a printer driver having a secret keeping operation "instructing said stencil printing machine to remove a used stencil sheet from a print drum and dispose of said used stencil sheet after [a selected] number of copies have been printed." (Claims 1 and 2).

Applicant respectfully submits that the Examiner has *not* shown that it would be obvious to one of ordinary skill in the art at the time the invention was made to add: (1) a secret keeping operation instructing a stencil printing machine to remove a used stencil sheet from a print drum; to (2) a printer driver. Applicant submits that, in considering the invention as a whole, the Examiner will find no motivation to combine Kurachi and Okuda *with each other* without relying on impermissible hindsight. Again, Kurachi is completely silent as to operations instructing the printing machine to "remove" or "dispose" of any physical element, and Okuda is completely silent as to a printer driver which would conduct such operations.

As the Examiner has failed to show proper motivation to combine AAPA, Kurachi, and Okuda, Applicant respectfully submits that the Examiner has failed to make a *prima facie* case of obviousness.

Reconsideration and withdrawal of the rejections are requested.

NEW CLAIM

Independent claim 3 is newly presented here for a first action on the merits, and discloses *inter alia* a printer driver with “setting items,” in which “if a watermark print item is selected on the setting items, the printer driver automatically instructs said stencil printing machine to remove a used stencil sheet from a print drum and dispose of said used stencil sheet after said number of copies have been printed.”

As the terminology of a “secret keeping operation” appears to have caused confusion, Applicant submits claim 3, with the above terminology, in which the printer *driver* instructs the machine to *remove a used stencil sheet and dispose of the used stencil sheet* after copies have been printed.

Applicant submits that Claim 3 is allowable over the sited prior art for at least the reason that neither AAPA, Kurachi, nor Okuda discloses, teaches, or suggests a “printer driver [that] automatically instructs [a] stencil printing machine to remove a used stencil sheet from a print drum and dispose of said used stencil sheet” after copies have been printed.

CONCLUSION

In light of the foregoing, Applicant submits that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicant respectfully requests that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicant petitions for an appropriate extension of

time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

NATH & ASSOCIATES PLLC

Date: January 9, 2007
THE NATH LAW GROUP
112 South West Street
Alexandria, VA 22314

Tel. (703) 548-6284
Fax. (703) 683-8396

By:

Gregory B. Kang
Gary M. Nath
Registration No. 26,965
Gregory B. Kang
Registration No. 45,273
Matthew J. Moffa
Registration No. 58,860
Customer No. 20529